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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,613	03/23/2004	Hong Liu		4470

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GENOMICS INSTITUTE OF THE NOVARTIS RESEARCH FOUNDATION 10675 JOHN JAY HOPKINS DRIVE, SUITE E225 SAN DIEGO, CA 92121-1127		

EXAMINER	
ANDERSON, REBECCA L	

ART UNIT	PAPER NUMBER
1626	

NOTIFICATION DATE	DELIVERY MODE
08/02/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPLegal@gnf.org
jclarke@gnf.org

Office Action Summary	Application No. 10/807,613	Applicant(s) LIU ET AL.	
	Examiner Rebecca L. Anderson	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 7-20, 23-25 and 27-38 is/are pending in the application.
- 4a) Of the above claim(s) 10-15 and 29-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1, 4, 7-9, 16-20, 23-25, 27, 28 and 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1, 4, 7-20, 23-25 and 27-38 are currently pending in the instant application. Claims 10-15 and 29-37 are withdrawn from consideration as being for non-elected subject matter. Claims 1, 4, 7-9, 16-20, 23-25, 27, 28 and 38 are objected to as containing non-elected subject matter.

Response to Amendment and Arguments

Applicant's amendment filed 31 May 2007 has overcome the objection to the claims as failing to have a period; has overcome the 112 1st paragraph rejection and has overcome the 112 2nd paragraph rejection. In regards to the objection to the claims as containing non-elected subject matter, applicants' arguments filed 31 May 2007 have been fully considered but they are not persuasive. Specifically, applicant argues that claims 10-15 fall within the elected invention, however, this is not persuasive, as stated on pages 3 and 4 of the restriction requirement, upon the election of a single compound, the Office will review the claims and disclosure to determine the scope of the independent invention encompassing the elected compound.

As stated in the previous office action, **the elected invention for search and examination is:**

The products of the formulas as found in claim 9 and claim 18 wherein:

R1 is a member selected from the group consisting of C6-C10 aryl substituted with 0-3 R1a or a C3-C8 cycloalkyl substituted with 0-2 R1b, wherein said C3-C8 cycloalkyl is saturated or unsaturated;

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each **R1a** is independently a member selected from the group consisting of H, C1-C3 perfluoroalkyl, C3-C7 cycloalkyl, F, Cl, Br, CN, NO₂, OR₁₀, SCH₃, S(=O)CH₃, S(=O)₂R₁₀, NR₁₁R₁₂, acetyl, C(=O)OR₁₃, C(=O)NR₁₃R₁₄, S(=O)₂NR₁₃R₁₄, phenyl substituted with 0-3 R₁₅ and a C1-C4 alkyl substituted with 0-2 R₁₆;

each **R1b** is independently a member selected from the group consisting of H, OH, F, Cl, acetyl, =O, C1-C6 alkyl, C1-C6 alkoxy, CF₃ and OCF₃;

R₂ is a member selected from the group consisting of a phenyl substituted with 0-3 R₁₅, a C1-C6 alkyl substituted with 0-2 R_{2a}, a C2-C6 alkenyl, a C2-C6 alkynyl, a C3-C7 cycloalkyl substituted with 0-2R₁₉, and a C7-C11 bicycloalkyl substituted with 0-2R₁₉;

each **R2a** is independently a member selected from the group consisting of a C6-C10 aryl substituted with 0-3 R₁₅ or a C3-C8 cycloalkyl substituted with 0-2R₁₉, and a C7-C11 bicycloalkyl substituted with 0-2 R₁₉;

R5 is a member selected from the group consisting of H, C3-C7 cycloalkyl, C2-C6 alkenyl, C2-C6 alkyne, phenyl substituted with 0-2R₁₅, or a C1-C6 alkyl substituted with 0-2R₁₈;

each **R10** is independently a member selected from the group consisting of H, C3-C7 cycloalkyl, a C1-C3 perfluoroalkyl, a C1-C4 alkyl substituted with 0-1 R₂₅, a phenyl substituted with 0-3 R₁₅;

each **R11** is independently a member selected from the group consisting of H, tBOC, Cbz, C3-C8cycloalkyl, (C1-C6 alkyl)-C(=O)-, (C1-C6 alkyl)-S(=O)₂- and a C1-C6 alkyl;

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each of **R12**, **R13**, and **R14** is independently a member selected from the group consisting of H and C1-C4 alkyl;

each **R15** is independently a member selected from the group consisting of H, OH, F, Cl, Br, I, CN, NO₂, COOR₁₃, C(=O)NR₁₃R₁₄, S(=O)₂NR₁₃R₁₄, acetyl, -SCH₃, -S(=O)CH₃, -S(=O)₂CH₃, NR₂₆R₂₇, C1-C6 alkoxy, C1-C3 perfluoroalkyl, C1-C3 perfluoroalkoxy and a C1-C6 alkyl;

each **R16** is independently a member selected from the group consisting of H, OH, COOR₁₃, C(=O)NR₁₃R₁₄, S(=O)₂NR₁₃R₁₄, acetyl, -SCH₃, S(=O)CH₃, S(=O)₂CH₃, C1-C6 alkoxy, NR₂₆R₂₇, a phenyl substituted with 0-3 R₁₅;

each **R18** is independently a member selected from the group consisting of H, OH, F, Cl, CN, NO₂, C(=O)OR₃₀, C(=O)NR₁₃R₁₄, NR₁₁R₁₂, a C1-C3 perfluoroalkyl, a C1-C3 perfluoroalkoxy, a phenyl substituted with 0-3 R₁₅ and a C3-C8 cycloalkyl;

each **R19** is independently a member selected from the group consisting of C1-C4 alkyl, F, Cl, and C1-C4 alkoxy, CF₃ and OCF₃;

each **R25** is independently a member selected from the group consisting of H, C3-C7 cycloalkyl, a phenyl substituted with 0-3 R₁₅;

each **R26** is independently a member selected from the group consisting of H, C1-C4 alkyl, (C1-C4 alkyl)-C(=O) and (C1-C4 alkyl)-S(=O)₂;

each **R27** is independently a member selected from the group consisting of H and C1-C4 alkyl;

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each **R28** is independently a member selected from the group consisting of H, a C1-C6 alkyl, C3-C8 cycloalkyl, a phenyl substituted with 0-3 R15, a benzyl substituted with 0-2 R15;

each **R29** is independently a member selected from the group consisting of H, F, Cl, Br, I, CN, NO₂, OR₂₈, SR₂₈, S(=O)₂R₂₈, S(=O)₂NR₁₃R₁₄, NR₂₇R₂₇, acetyl, C(=O)NR₁₃R₁₄, C(=O)OR₁₃, C1-C6 alkyl, OCHF₂, SCF₃, OCF₃, -C(=NH)NH₂; and

each **R30** is independently a member selected from the group consisting of H, C3-C7 cycloalkyl, C1-C4 alkyl substituted with 0-1 R₂₅, a phenyl substituted with 0-3 R₁₅.

The restriction requirement is still deemed proper and is FINAL.

Applicant argues that the examiner has not followed 809.02. It is noted that the restriction requirement was made under 35 USC 121. 35 USC 121 gives the Commissioner (Director) the authority to limit the examination of an application where two or more independent and distinct inventions are claimed to only one invention. The examiner has indicated that more than one independent and distinct invention is claimed in this application and has restricted (limited) claimed subject matter accordingly. Thus the requirement to restrict the claims in this application is predicated on the fact that the claimed subject matter involves more than one independent and distinct invention. Nowhere do applicants argue to the contrary. No where do applicants point out and give reasons why the claims do not involve independent or distinct subject matter. So, here we have claims, which involve more than one independent or distinct inventions. Under 35 USC 121, the claims may be restricted and the examination limited

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to a restricted invention. The issue here is one of restriction. 35 USC 121 gives the Commissioner the authority to restrict to one invention those applications which contain two or more inventions, i.e. limit the examination of an application to a single invention. Thus, the requirement to restrict in this application is predicated on the fact that the elected subject matter taken as a whole and the non-elected subject matter taken as a whole are so different in structure and element as to be patentably distinct, i.e. a reference which anticipated but one group of compounds would not even render obvious the other group. So, here we have claims, which involve more than one independent or distinct invention. Under 35 USC 121, the claims may be restricted and the examination limited to a restricted invention. Accordingly, restriction as has been presented in this application is proper.

Applicant also argues that there is no undue burdensome search. This argument is not persuasive as the inventions are independent and distinct because there is no patentable co-action between the groups and a reference anticipating one member will not render another obvious. Each group is directed to art recognized divergent subject matter which require different searching strategies for each group. Moreover, the examiner must perform a commercial database search on the subject matter of each group in addition to a paper search, which is quite burdensome to the examiner.

Claim Objections

Claims 1, 4, 7-9, 16-20 and 23-25, 27, 28 and 38 are objected to as containing non-elected subject matter. Claims 1, 4, 7-9, 16-20 and 23-25, 27, 28 and 38 presented

drawn solely to the elected invention as identified supra as the elected invention for search and examination would overcome this objection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday from 6:00am until 2:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Rebecca Anderson/
Primary Examiner, AU 1626*

25 July 2007

Rebecca Anderson
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